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10/748,870	12/29/2003	Jeffrey A. Dean	Google-35APP (GP-090-00-U	3713

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EXAMINER	
TSUI, WILSON W	
ART UNIT	PAPER NUMBER
2178	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/748,870	DEAN ET AL.	
	Examiner	Art Unit	
	WILSON TSUI	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 November 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-15 and 17-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-7,9-15 and 17-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This final action is in response to the amendment filed on: 11/20/09.

2. Claims 1-7, 9, 15, and 17-20 are amended. Claims 1, 7, 9, and 15 are independent claims. Claims 8 and 16 are cancelled. Claims 1-7, 9-15, and 17-20 are pending.

3. With regards to claims 1-16, the 35 USC 101 rejections are withdrawn, in view of applicant's amendments.

4. The following rejections are withdrawn, in view of new grounds of rejection necessitated by applicant's amendments:

- Claims 1, 7, 9, 15, and 20 rejected under 35 U.S.C. 102(e) as being anticipated by Barry et al.
- Claims 2, 10, and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al, in further view of ProductReview.
- Claims 3, 8, 11, 16, and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al, in further view of CNET.
- Claims 4, 12, and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al, in further view of MSN.
- Claims 5 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al, in further view of Bowman et al.
- Claims 6 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al, in further view of Weaver.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 5, 7, 9, 13, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens et al (US Patent: 7,076,443 B1, issued: May 31, 2000, filed: Jul. 11, 2006), in further view of Barry et al (US Application: 2004/0015397 A1, published: Jan. 22, 2004, filed: Dec. 4, 2002, EEFD: Jul. 16, 2002).

With regards to claim 1, Emens et al teaches:

a) Accepting, by a computer system including one or more computers on a network, ad document information (column 5, lines 20-43: whereas, a computer system receives product data from a search engine server. The search engine server provides results for advertising data parameters, since the computer system/product matching manager uses the search engine results for advertising purposes).

b) Using, by the computer system, at least one of terms, concepts, and categories from the content of the ad document information to determine relevant content, from a content server, in addition to content of the ad document, wherein the determined relevant content is one of (A) a news story, (B) a review, (C) a search query, and (D) a user group message and; (column 5, lines 58-63: whereas, the computer system uses at least one or more product terms from the content of the ad/product information to

determine more relevant product advertising data, by using determined match/query content to retrieve product advertisements from a content/product server).

c) combining, by the computer system, at least a portion of content of the ad document, from the ad server, and at least a portion of the determined content (column 5, lines 44-64: whereas, the search results are displayed, along with additional content information represented in a product icon), wherein the ad document (whereas, product data) ..., and wherein the page content is not directly used to determine the determined relevant content (wherein the displayed page data by the request server is not used to determine additional content, but rather is used to display the combined content data).

However, Emens does not expressly teach the ad document is at least one ad.

Yet, Barry et al teaches the ad document is at least one ad (Fig 15: whereas a web page server, serves a document containing at least one ad).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Emens et al's method for automatically associated related advertisement data to search results, such that the search results from a server, can contain a web page having at least one advertisement, as taught by Barry et al. The combination would have allowed Emens et al to have "assimilated and displayed internet advertisements that do not rely on user profiling during an Internet search to individual users" (Emens et al: column 2, lines 5-10).

With regards to claim 5, which depends on claim 1, the combination of Emens et al and Barry et al teaches a method comprising t*he determined content*, in claim 1, and is rejected under the same rationale.

Additionally Emens et al teaches the determined content *is a search query related to the document,* as similarly explained in the rejection for claim 1, and is rejected under similar rationale.

With regards to claim 7, Emens et al teaches:

a) *accepting, by a computer system including one or more computers on a network, document content information* (column 5, lines 20-43: whereas the computer system accepts search result document content information)*;*

b) *using, by the computer system, at least one of terms, concepts and categories of the document content information to determine relevant content in addition to content of the document, wherein the determined relevant content is one of* (A) a news story, (B) a review, (C) a search query, and (D) a user group message (column 5, lines 58-63: whereas, the computer system uses at least one or more product terms from the content of the ad/product information to determine more relevant product advertising data, by using determined match/query content to retrieve product advertisements from a content/product server);

c) *using, by the computer system, the determined relevant content*; and d) Combining, by the computer system, at least a portion of content of the document, at least a portion

of the determined relevant content (column 5, lines 44-64: whereas, the search results are displayed, along with additional content information represented in a product icon).

However, although Emens teaches that determined content can be at least one ad, and also combining portions of content and determined content; Emens does not expressly teach using the determined relevant content, *determining further content wherein the further determined content is at least one ad, received from an ad server, relevant to the determined relevant content; and* ... including in the combination *at least a portion of the determined further content for presentation to a user*.

Yet Barry et al teaches using the determined relevant content, *determining further content wherein the further determined content is at least one ad, received from an ad server, relevant to the determined relevant content* (Fig 15, paragraph 0064: whereas, based upon information of the determined ad, another further ad is selected)*; and* ... including in the combination *at least a portion of the determined further content for presentation to a user* (Fig 15, paragraph 0064: whereas, the determined content, further determined content, and the content of the page residing at the particular level of content are combined together).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Emens method for using document result information from a server and retrieving further information based upon document results, such that from determined relevant content, further content is determined to include an ad, as taught by Barry et al. The combination of would have allowed Emens et al to have "assimilated

and displayed internet advertisements that do not rely on user profiling during an Internet search to individual users" (Emens et al: column 2, lines 5-10).
With regards to claim 9, Emens et al and Barry et al teach an Apparatus, which performs a method similar to the method of claim 1, is rejected under similar rationale.

With regards to claim 13, for an apparatus performing a similar method as in claim 5, is rejected under the same rationale.

With regards to claim 15, Emens et al and Barry et al teach an Apparatus, which performs a method similar to the method of claim 7, is rejected under similar rationale.

With regards to claim 20, which depends on claim 7, Emens et al and Barry et al teaches *wherein the acts of (b) using the document information to determine content in addition to content of the document, (c) using the determined content, determining further content, and (d) combining at least a portion of content of the document, at least a portion of the determined content, and at least a portion of the determined further content for presentation to a user* (as similarly explained in the rejection for claim 7), and rejected under similar rationale. Furthermore the combination of Emens et al and Barry et al further teach that the acts are performed automatically by a machine executing machine-executable instructions (column 3, lines 30-44 of Emens et al: whereas, instructions are executable by a machine for automatic implementation of a

method. Additionally, as explained in Barry et al, page 8, claim 10: whereas a system comprising a storage, is used to execute steps).

6. Claims 2, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens et al (US Patent: 7,076,443 B1, issued: May 31, 2000, filed: Jul. 11, 2006), in view of Barry et al (US Application: 2004/0015397 A1, published: Jan. 22, 2004, filed: Dec. 4, 2002, EEFD: Jul. 16, 2002), and further in view of ProductReview (Edmunds.com, Page 1, Jan. 22, 2001).

With regards to claim 2, which depends on claim 1, the combination of Emens et al and Barry et al teaches a method comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.
- *The determined content*, in claim 1, and is rejected under the same rationale.
- An ad database, which stores advertisement listings and an *ad is for a product* (Abstract of Emens et al: whereas product advertisements are retrieved. Also as explained in Barry et al, page 8, claim 10 , and Fig 15: whereas a breast pump is a product), .

However, although Emens et al and Barry et al teaches that an additional ad, can be of a particular subject matter (Barry et al, paragraph 0004: whereas advertisements are selected based on subject matter), the combination of Emens et al and Barry et al does not expressly show that the determined content is *a review for the product*.

ProductReview teaches the *at least one ad is for a product and wherein the determined content is a review for the product* (page 1: whereas, a car is the product, and through inherent display constraints, only additional content concerning a review of the particular car is displayed on the right hand side of the page).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Emens et al and Barry et al's method for displaying advertisements of a particular subject matter and determining further content; to have further included an advertisement for the determined content to be a review for a product, as taught by ProductReview. The combination of Barry et al, and ProductReview, would have allowed Barry et al's system to have been able to provide product review information when the ad is a product.

With regards to claim 10, which is dependent on claim 9, for an apparatus performing a similar method to claim 2, is rejected under the same rationale.

With regards to claim 17, which depends on claim 2, the combination of Emens et al and Barry et al teaches *wherein the acts of (b) using the ad document information to determine content in addition to content of the ad document, and (c) combining at least a portion of content of the ad document and at least a portion of the determined content for presentation to a user together with page content* (as similarly explained in the rejection for claim 1), and is rejected under similar rationale. Additionally, Emens et al and Barry et al teach the acts *are performed automatically by a machine executing*

machine-executable instructions (column 3, lines 30-44 of Emens et al: whereas, instructions are executable by a machine for automatic implementation of a method. Additionally, as explained in Barry et al, page 8, claim 10: whereas a system comprising a storage, is used to execute steps).

7. Claims 3, 8, 11, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens et al (US Patent: 7,076,443 B1, issued: May 31, 2000, filed: Jul. 11, 2006), in view of Barry et al (US Application: 2004/0015397 A1, published: Jan. 22, 2004, filed: Dec. 4, 2002, EEFD: Jul. 16, 2002) and further in view of CNET (CNET.COM, page 1, December 7, 2001).

With regards to claim 3, which depends on claim 1, the combination of Emens et al and Barry et al teaches a method comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.
- *The determined content*, in claim 1, and is rejected under the same rationale.
- An ad database, which stores advertisement listings (page 8, claim 10 of Barry et al), and an *ad is for a service* (Abstract of Barry et al: whereas audiences can be interested in service advertisements).

However, the combination of Emens et al and Barry et al does not expressly teach that the determined content *is a review for the service*.

Yet, CNET teaches at least one ad *is for a service and wherein* the determined content *is a review for the service* (page 1: whereas, 'PC Connection' is the name of the service, and the review is indicated by a "star" ranking system).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Emens et al and Barry et al's method for displaying advertisements of a particular subject matter and determining further content, to have further included an advertisement for the determined content to be a review for a service, when a service was being browsed, as taught by CNET. The combination of Emens et al, Barry et al, and CNET, would have allowed Barry et al's system to have been able to have provided service review information when the ad was a service.

With regards to claim 8, which depends on claim 7, Emens et al, Barry et al and CNET teach *wherein the determined content is one of a review*, in claim 3, and is rejected under the same rationale.

Furthermore, Barry et et al teaches *wherein the further determined content is at least one ad relevant to the determined content* (as similarly explained in the rejection for claim 7, since the advertisements are selected based upon several factors included a particular content level).

With regards to claim 11, which depends on claim 9, for an apparatus performing a method similar to claim 3, is rejected under the same rationale.

With regards to claim 16, which depends on claim 15, for an apparatus performing a similar method to the method in claim 8, is rejected under the same rationale.

With regards to claim 18, which depends on claim 3, Emens et al, and Barry et al teaches *wherein the acts of (b) using the ad document information to determine content in addition to content of the ad document, and (c) combining at least a portion of content of the ad document and at least a portion of the determined content for presentation to a user together with page content* (as similarly explained in the rejection for claim 1), and rejected under similar rationale. Additionally Emens et al and Barry et al teach that the acts *are performed automatically by a machine executing machine-executable instructions* (column 3, lines 30-44 of Emens et al: whereas, instructions are executable by a machine for automatic implementation of a method. Additionally, as explained in Barry et al, page 8, claim 10: whereas a system comprising a storage, is used to execute steps). .

8. Claims 4, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens et al (US Patent: 7,076,443 B1, issued: May 31, 2000, filed: Jul. 11, 2006), in view of Barry et al (US Application: 2004/0015397 A1, published: Jan. 22, 2004, filed: Dec. 4, 2002, EEFD: Jul. 16, 2002), and further in view of MSN (MSN.COM, page 1, Dec. 7, 2000).

With regards to claim 4, which depends on claim 1, Emens et al and Barry et al teaches a method comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.
- *The determined content*, in claim 1, and is rejected under the same rationale.
- An ad database, which stores advertisement listings (page 8, claim 10 of Barry et al), and an *ad is for a service* (Abstract of Barry et al: whereas audiences can be interested in service advertisements).

However, Emens et al and Barry et al does not expressly teach *wherein* the determined content *is a news story about the product or service*.

Yet, MSN teaches at least one ad *is for a product or service and wherein* the determined content *is a news story about the product or service* (MSN, page 1: whereas, MSN Messenger is the service, and news about MSN Messenger is provided as additional content).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Emens et al and Barry et al's method for displaying advertisements of a particular subject matter and determining content, to have further included an advertisement for the determined content to display a news story about a service as taught by MSN. The combination of Emens et al, Barry et al and MSN, would have allowed Emens et al's system to have been able to have provided service news information when the ad was a service type.

With regards to claim 12, which is depends on claim 9, for an apparatus performing a method similar to claim 4, is rejected under the same rationale.

With regards to claim 19, which depends on claim 4, Emens et al and Barry et al teach wherein the acts of (b) using the ad document information to determine content in addition to content of the ad document, and (c) combining at least a portion of content of the ad document and at least a portion of the determined content of presentation to a user together with page content (as similarly explained in the rejection for claim 1), and rejected under similar rationale. Additionally, Emens et al and Barry et al further teach the acts are performed automatically by a machine executing machine-executable instructions (column 3, lines 30-44 of Emens et al: whereas, instructions are executable by a machine for automatic implementation of a method. Additionally, as explained in Barry et al, page 8, claim 10: whereas a system comprising a storage, is used to execute steps).

9. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emens et al (US Patent: 7,076,443 B1, issued: May 31, 2000, filed: Jul. 11, 2006), in view of Barry et al (US Application: 2004/0015397 A1, published: Jan. 22, 2004, filed: Dec. 4, 2002, EEFD: Jul. 16, 2002), and further in view of Weaver (US Application: US 2004/0093558 A1, published: May 13, 2004, filed: Oct. 29, 2003, EEFD: Oct 29, 2002).

With regards to claim 6, which depends on claim 1, Emens et al and Barry et al teaches a method comprising *the determined content*, in claim 1, and is rejected under the same rationale. Furthermore, Emens et al and Barry et al teaches determining the content by going through an advertisement database for related content level, as explained in claim 1. However, Barry et al does not teach the determined content *is a message from a user group.*

Weaver teaches a message database that stores *messages from a user group* (claim 2).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Emens et al and Barry et al's advertisement database, which has associated advertisements associated with a particular content-level/concepts; to have been a database that also stored messages (as taught by Weaver), such that the stored messages are associated with concepts. The combination would have allowed Emens et al's system to have been able to determine the most appropriate user group message based on the document content.

With regards to claim 14, which depends on claim 9, for an apparatus performing a similar method to claim 6, is rejected under the same rationale.

Response to Arguments

10. Applicant's arguments with respect to claims 1-7, 9-15, and 17-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILSON TSUI whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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